

Application No. 10/228,622

Response to Office Action of January 13, 2006

### **REMARKS**

In the Office Action of January 13, 2006, claims 1-2, 4, 9-10, 12, 19-20 and 26 stand rejected. Claims 21-25 are withdrawn. Claims 1 and 9 have been amended. Reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks. No new subject matter is being added by this response.

#### **I. CLAIM REJECTIONS.**

##### **A. 35 U.S.C. § 102 Rejections.**

Claims 1-2, 4, 9-10, 12, 19-20 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by an Internet article entitled Automotive News Digest (hereinafter "*Digest*").

In order to maintain a §102 rejection the single prior art reference must disclose each element of the claim under construction. In re Dillon, 16 U.S.P.Q. 2d, 1897, 1908 (Fed. Cir. 1990) (en banc), cert denied 500 U.S. 904 (1991). Further, the identical situation must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 9 U.S.P.Q. 2d, 1915, 1920 (Fed. Cir. 1989). Not only must the same level of detail must be shown in the prior art, the prior art must disclose each and every element of the claimed invention, arranged as in the claims. Hindemann Mashihenfabrile GMBH v. American Hoist & Derrick Co., 721 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Because the Examiner has failed to provide prior art that discloses each element, the Applicant respectfully traverses this rejection.

1. The *Digest* Reference fails to teach all claim limitations.

*Digest* appears to disclose an Internet auction system in which remote bidders can bid on automobiles being auctioned at a traditional auction. In *Digest*, it is noted that the advantage of the disclosed system is to allow dealers to bid for cars at a remote auction as if they were at the actual auction, "All a dealer needs is a computer and a standard telephone line to join with buyers and sellers on the auction floor."

Note that nothing in *Digest* discloses storing a listing of automobiles owned by a rental car company, making the listing of automobiles available over a computer network, or receiving a buy request as are disclosed in claim 1 and similarly in claim 9. Instead, the user of the *Digest's* system is a participant in an old-fashioned auction that allows for remote participation.

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Certainly nothing in *Digest* discloses that the automobiles are continuously available for use as a rental car while listed for sale. Thus, the art cited by the Examiner does not anticipate the pending claims and the rejection should be withdrawn.

2. The Examiner's use of Official Notice is improper.

In addition to citing *Digest*, the Examiner takes Official Notice that rental car companies routinely use the auction of the prior art to sell their rental fleet. This evidently is to provide the connection between the cited art and the concept of rental car sales. The Examiner provides no evidence to support his assertion of Official Notice. However, taking Official Notice in this case is inappropriate. First, taking Official Notice without documentary support is permissible only in limited circumstances and the circumstances should be rare when an application is under final rejection. MPEP § 2111. It is not appropriate for an Examiner to take Official Notice without citing a prior art reference where the facts to be asserted are not capable of instant and unquestionable demonstration as being well known. MPEP § 2111.

This is certainly not the case in this rejection. Whether rental car companies routinely used auctions as described in *Digest* at the time the patent application was filed is not a fact that can be instantly and unquestionably demonstrated. As noted in the background, at the time the application was filed, rental cars were typically sold at auctions or through other sales channels after being removed from the rental car fleet and were not sold via auctions broadcasted over the Internet. Also, the Examiner's Official Notice statement is conclusive in nature and does not provide any basis for his reasoning. Thus, the Applicant requests that this Official Notice be supported by adequate evidence or this rejection under §102 be withdrawn in the next response.

Also, note that in *Digest*, the type of auction disclosed provides live audio and video over the Internet to remote buyers of cars being auctioned at an auction site. Essentially, the system in *Digest* allows bidders to view and participate in a live auction remotely. Participating in a live auction, even one that is being broadcast over the Internet, is not the same as "making the listing of automobiles available over the computer network" as in claim 1 and similarly in claim 9. Thus, even if the Examiner is correct in his "Official Notice", and rental car companies continuously used auctions of the type disclosed in *Digest* not all of the claim limitations would be met.

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The eBay article included with the cited art in the Final Office Action of January 13, 2006 has a priority date of March 7, 2000, which is less than one year prior to the present inventions priority date of June 20, 2000 and is, therefore, not proper prior art. However, it is important to note that even if the eBay article was proper prior art, it too fails to disclose a listing of automobiles owned by a rental car company or making the listing available over the Internet. The eBay article only discloses individuals selling used cars over the Internet, not rental car companies. Nowhere in the eBay article is there disclosed "providing a listing of automobiles owned by a rental car company." Note that taking Official Notice that these types of Internet auctions were used to sell rental cars as of the priority date would also be illegitimate without support by adequate evidence.

3. The Examiner improperly interrupted the term "Available"

The Examiner further argues that the limitation of the automobiles available for rental while listed for sale is met because the definition of available includes automobiles at auction because the titles are not transferred until sold and the cars are, therefore, technically "legally available for rental". While the Applicant appreciates that it is the Examiner's job to interpret claims broadly during prosecution, it is important to note that claims are to be given their broadest, most reasonable interpretation. Indeed, as stated in the MPEP, "the claims are to be given the broadest reasonable meanings of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition that may be afforded by the written description contained in the Applicant's specification." MPEP § 2111, quoting In re Cortright, 49 USPQ 1464, 1468 (Fed. Cir. 1999).

The Examiner, when interpreting the word "available" offered no definition for the word available, only providing a situation to which, the Examiner claims, the word available would apply. Seemingly, the Examiner is defining the word available as available in any time frame or under any conditions. Indeed, the Examiner's example seemingly provides that if something is legally available it is available. However, definitions of available do not support the expansive interpretation offered by the Examiner.

For example, the online dictionary at <http://education.yahoo.com/reference/dictionary/entry/available> defines available as "present and

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ready for use, at hand, accessible.” Yahoo uses the American Heritage Dictionary, fourth edition. Clearly, under this definition, a rental car at an auction is not available for rental because the rental car is no longer present and ready for use. The rental car would have to be, at the very least, moved to the rental car location.

Common sense supports this definition of available. If one was told rental cars were available, one would expect to be able to go to the rental car location and rent the rental car. One would not expect to be told that there were actually no cars at the rental car location but since the rental car company held legal title to a rental car at an auction lot a car was “available.” That is because when one is told that an item is available for rental or purchase, one expects it to be ready for rental or purchase, or at hand for rental or purchase. The Examiner is adding additional broadening language to the word available by defining available as “legally” available. Thus, the broad interpretation of the word “available” provided by the Examiner is not a reasonable interpretation and should be withdrawn.

4. Amendments to the claims overcome all pending rejections.

In order to advance prosecution of the case the Applicant has amended claim 1 to recite, in part, “the automobile continuously available for use as a rental car while listed for sale” and claim 9 to recite, in part, “store a listing of rental cars available for sale while simultaneously available for use as a rental car.” These amendments include the limitation that a rental car is continuously (or simultaneously for claim 9) available for rent when listed for sale. These amendments clearly point out how the rental cars are available for rent when also listed for sale. These limitation are not found in any cited prior art. Thus, claim 1 and claim 9 and all claims depending from claims 1 and 9 are in condition for allowance.

## **II. FINALITY OF ACTION.**

The Office Action of January 13, 2006 is a final action. However, Applicant argues that the amendments to claims 1 and 9 should be entered because they do not raise any new issues or require any additional searching. The Examiner argues that he interpreted the word available as broadly as possible. It can therefore be assumed that the Examiner did a search using a broad definition of available. Thus, any limitations that narrow the scope of the word available would

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have also been searched in the Examiner's search using a broad definition of available. Thus, since the amendments merely clarified the definition of available, the amended claims fall within a subset of what the Examiner has already searched. Therefore, the amendments could not raise issues requiring a new search.

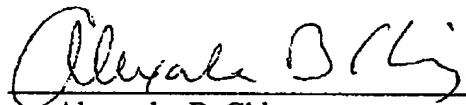
Further, the Examiner's use of Official Notice, as discussed previously, is inappropriate and the Examiner is requested to provide evidence to support the Official Notice or withdraw the rejections. Thus, the Applicant requests the finality of the last action be removed and evidence to support the Official Notice be provided or the rejections removed and all claims allowed.

### III. CONCLUSION

For the foregoing reasons, the present application is believed to be in condition for allowance and favorable action is respectfully requested. The Examiner is invited to telephone the undersigned at the telephone number listed below if it would in any way advance prosecution of this case.

Respectfully submitted,

March 13, 2006  
Date

By   
Alexander B. Ching  
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